

DEC 14 2006

60,469-235  
OT-5020IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Siewert, Bryan Robert  
Serial No.: 10/550,655  
Filed: 09/27/2005  
Group Art Unit: 3654  
Examiner: Kruer, Stefan  
Title: ELEVATOR SYSTEM WITH A STATIC COUNTERWEIGHT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to the Office Action mailed on November 14, 2006. Applicant hereby elects Group 1, Species 1, claims 1-6 and 8. This election is made with traverse.

The Examiner asserts that the application contains claims directed to more than one species of the generic invention and that the species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicant respectfully traverses.

As the Examiner has stated, this application is subject to the PCT Rules 13.1 to 13.4 (unity of invention). M.P.E.P. § 1893.03(d) states: "When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (*i.e.*, why there is no single general inventive concept) specifically describing the unique special technical feature in each group." Applicant submits that, while the Examiner states he is using unity of invention, it appears that the restriction is based on U.S. practice under M.P.E.P. § 800. Applicant notes that the Examiner has cited M.P.E.P. § 809.02(a), which does not apply to this application. Also, the Examiner has cited to 37 C.F.R. § 1.141, which is improper. The proper rule is 37 C.F.R. § 1.499. *See* M.P.E.P. § 1893.03(d).

Under PCT Rules 13.1 and 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. Because this application is a national filing from a PCT application, PCT Rules 13.1 to 13.4 and M.P.E.P. § 189.03(d) must be followed. The administrative instructions under the PCT (M.P.E.P. Appendix A1) explain,

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"Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect to any of the claims that depend on the independent claims. In particular, it does not matter if the dependent claim itself contains a further invention." Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. See Annex B, Unity of Invention, Part 1(c)(i).

In order for a restriction requirement to be imposed in this application, the Examiner must perform an examination and cite to the prior art that would make the claims not patentable. Without that, the restriction requirement is baseless and must be withdrawn.

The Examiner is incorrect in stating, "The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical features." Both independent claims were considered during the international examination phase and found to meet the requirements of PCT Articles 33(2)-(3).

Examination of all claims is required.

Respectfully submitted,

CARLSON, GASKEY & OLDS

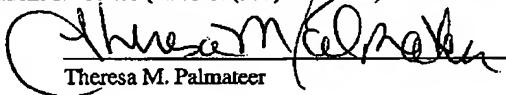


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Dated: December 14, 2006

**CERTIFICATE OF FACSIMILE**

I hereby certify that this Response to Restriction Requirement, relative to Application Serial No. 10/550,655 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on December 14, 2006.



Theresa M. Palmateer

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